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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,659	12/29/1999	MAKOTO KIKUGAWA	35.G2530	1271
5514	7590	11/26/2003	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			PHAM, THIERRY L	
		ART UNIT		PAPER NUMBER
		2624		
DATE MAILED: 11/26/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/473,659	KIKUGAWA, MAKOTO
	Examiner Thierry L Pham	Art Unit 2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-51 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-51 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda (U.S. 6181440), and in view of Zdunek et al (U.S. 4992783).

2. Regarding claims 1 & 10, Masuda discloses an apparatus for conducting a retrieval of document data, comprising:
 - (1) storing means (Memory, Fig. 1) for storing the document data;
 - (2) a receiver (facsimile device, Fig. 1, col. 2, lines 63-67 and col. 3, lines 1-33), for receiving from a user a request for retrieval of the document data, with the request including a password (col. 3, lines 8-33);
 - (3) a transmitter (network control unit, Fig. 1, col. 3, lines 8-48), for transmitting the password, received by said receiver, to a managing unit (FAX system control unit, Fig. 1) on a network;
 - (4) deciding means (FAX System control unit, Fig. 1, col. 6, lines 1-9) for, when said managing unit confirms the password transmitted by said transmitter, receiving a confirmation result from said managing unit to decide, on the basis of said confirmation result, whether or not the user is an authorized user;

(5) retrieving means (FAX system control unit, Fig. 1, col. 6, lines 1-22) for retrieving the document data stored in said storing means according to a decision result obtained by said deciding means;

(6) outputting means (printer unit, Fig. 1, col. 6, lines 1-9) for outputting document data retrieved by said retrieving means;

However, Masuda does not disclose expressly, wherein an apparatus for conducting a retrieval of document data, comprising:

(1) issuing means for automatically issuing a new password in response to receiving from a user a request for retrieval of the document data by said receiver; and

(2) registering means for transmitting the new password, issued by said issuing means, to said managing unit to register the new password as a valid password.

Zdunek, in the same field of endeavor for passwords protected access to documents, discloses:

(1) issuing means for automatically (col. 9, lines 3-12) issuing a new password in response to receiving from a user a request for retrieval of the document data by said receiver; and

(2) registering means (Fig. 4, col. 9, lines 3-40) for transmitting the new password, issued by said issuing means, to said managing unit to register the new password as a valid password.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Masuda as per teachings of Zdunek because of a following reason: to prevent print out of confidential reception images/documents (Masuda, col. 5, lines 55-65)

Therefore, it would have been obvious to combine Masuda with Zdunek to obtain the invention as specified in claim 1.

3. Regarding claims 2 & 11, Masuda further discloses an apparatus according to claim 1, wherein said receiver includes a local receiver (control panel, Fig. 1) for receiving a request from the user, if a local user, and a remote receiver (network control unit, Fig. 1) for receiving a request sent from the user, if a remote user, through a network.

4. Regarding claims 3 & 12, Masuda further discloses an apparatus according to claim 2, further comprising a control panel (control panel, fig. 1, col. 3, lines 8-33) for performing a predetermined display in response to a key operation by the user, wherein said local receiver receives a retrieval request and a password inputted from said control panel.

5. Regarding claims 4 & 13, Masuda further discloses an apparatus according to claim 2, further comprising a reader (scanner, Fig. 1), for reading an original to produce image information, wherein said local receiver receives a retrieval request and a password extracted from the image information taken by said reader.

6. Regarding claims 5 & 14-15, Masuda further discloses an apparatus according to claim 2, wherein said remote receiver receives a retrieval request and a password sent from a terminal through a network (Fig. 1, col. 3, lines 44-48).

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7. Regarding claims 6 & 16, Masuda further discloses an apparatus according to claim 2, wherein said remote receiver a retrieval request and a password extracted from image information sent from a terminal through a network (Fig. 1, col. 3, lines 44-48).
8. Regarding claims 7 & 17, Masuda further discloses an apparatus according to claim 2, further comprising a facsimile receiver (facsimile device, Fig. 10 for receiving a facsimile image, wherein said remote receiver receives a document a retrieval request and a password extracted from an image which said facsimile receiver receives.
9. Regarding claim 8, Masuda further discloses an apparatus according to claim 2, wherein said outputting means outputs document data in a different manner (printer provided by facsimile device, Fig. 1 & 6, or transmits the documents to the information processing device, Fig. 1 & 6, col. 5, lines 9-54) in accordance with whether said receiver behaves as said local receiver or said remote receiver.
10. Regarding claim 9, Masuda further discloses an apparatus according to claim 8, further comprising a facsimile transmitter (facsimile device 1, Fig. 1) for conducting a facsimile transmission to a predetermined address, wherein said outputting means, when a retrieval request is receive through a facsimile reception, transmits document data retrieved by said retrieving means in the form of a facsimile image to a retrieval requesting facsimile unit through the use of said facsimile transmitter.

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11. Regarding claims 18-34: Claims 18-34 are the method claims corresponding to the apparatus claims 1-9 (respectively). The method claims are inherent and included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-9 above.

12. Claims 35-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda (6181440), and to Zdunek et al (U.S. 4992783), and further in view of Pearlman et al. (US patent 5,764,807).

The combinations of Masuda and Zdunek, as discussed in apparatus claims 1-9 above, and also teaches the corresponding method claims 18-34. However, the combinations do not explicitly teach a storage medium (a computer readable medium) as recited in the claims.

Pearlman teaches a record medium for storing a computer program product comprising a computer readable medium and a computer program. (Column 2, lines 47-53)

It is desirable to make a processing method portable from a computer to another computer. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to store the processing steps of the method taught by Masuda and Zdunek in a computer readable medium taught by Pearlman, because the combination makes the processing method portable and therefore increase its application.

Response to Arguments

Applicant's arguments filed 10/31/2003 have been fully considered but they are not persuasive.

Rejection Under 35 U.S.C. § 103

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With respect to applicant's argument for claims 1 & 10, that "issuing means for issuing a new password 'automatically', and issuing the new password 'automatically' in response to receiving from a user a request for retrieval of document data", has been considered.

In reply: The limitations of "issuing means for issuing a new password 'automatically', and issuing the new password 'automatically' in response to receiving from a user a request for retrieval of document data" are not in claims 1 & 10.

Action is Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (8:30 AM - 5:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-5397 for regular communications and (703)308-5397 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Thierry L. Pham


November 24, 2003



DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600